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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/486,558 04/13/00 MAUBRU

M 05725.0555

EXAMINER

IM52/0614

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EINSMANN, M	
ART UNIT	PAPER NUMBER

1751
DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/486,558	MAUBRU ET AL.	
	Examiner Margaret Einsmann	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 March 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 20-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 20-47 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

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Claim Rejections

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

The rejection of Claims 20-24 and 26-47 under 35 U.S.C. 103(a) as being unpatentable over Lowe has been overcome by applicant's arguments that the halogenated coupler as claimed is not within the scope of the coupler of Lowe and that the examiner has not provided motivation to substitute the claimed coupler in the compositions of Lowe.

Claims 20-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalopissis in view of Clausen.

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Kalopissis, U.S. Patent No. 3,918,896, teaches compositions for dyeing hair which contain at least one oxidation base in combination with at least one halogenated coupler of formula (I) as claimed, see Abstract. Kalopissis teaches that p-aminophenol oxidation bases may be used, particularly when mahogany or chestnut colors are desired, see col. 2, lines 44-50. Kalopissis teaches that the oxidation bases and couplers may be present in mediums as claimed in the claimed amounts at the claimed pH's, see col. 3, lines 22-24; 45-49 and 61-66. The compositions are applied to hair with oxidants as claimed in methods as claimed, see col. 3, line 67-col. 4, line 7. Kalopissis exemplifies various compositions which contain a coupler as claimed in combination with p-aminophenol, which compositions are applied to hair in dyeing methods resulting in chestnut, mahogany or red hair colors, see Examples 22, 27 and 32. Kalopissis does not teach pyrazole oxidation bases as claimed, and does not specifically teach the claimed kits.

Clausen, U.S. Patent No. 5,061,289, teaches hair dyeing compositions which contain a developer and coupler, wherein the developer is a diaminopyrazole of formula (I), which diaminopyrazoles encompass those as claimed, and are used in the claimed amounts, see col. 1, line 63-col. 2, line 22. Clausen teaches that such diaminopyrazoles are used to dye hair brilliant red shades with a great depth of color when combined with conventional couplers, and that such developers are physiologically acceptable as compared to p-aminophenol which is conventionally used to obtain red shades, see col. 1, lines 38-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to at least partially substitute the p-aminophenol oxidation base of Kalopissis, such as in the

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patentee's Examples 22, 27 and 32, with a diaminopyrazole as claimed in the claimed amounts, resulting in dyeing compositions and methods as claimed, because Clausen teaches that the claimed diaminopyrazoles are an improvement over p-aminophenol because they have better physiological properties. Furthermore, Clausen teaches that the claimed diaminopyrazoles obtain brilliant red shades when combined with conventional couplers, further motivating those skilled in the art to replace Kalopissis's red oxidation base p-aminophenol with a diaminopyrazole oxidation base as claimed, absent a showing otherwise. The Office holds the position that the containment of the compositions of Kalopissis as modified by Clausen in kits as claimed would have been obvious to those skilled in the hair dyeing art because such kits are conventional for the storage of two-part oxidative hair dyeing compositions.

Response to Arguments

1. Applicant's arguments filed 3/16/2001 regarding the above rejection have been fully considered but they are not persuasive. In response to applicant's argument that there is no suggestion in Kalopissis to substitute the diaminopyrazoles for the oxidation basis specifically required by Kalopissis, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). One of ordinary skill in

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the art knows that oxidation basis are always used in combinations in order to modify the color produced. Since the secondary reference to Clausen et al. teaches that the diaminopyrazoles are an improvement over both the p-aminophenols over the pyrimidine developers of Kalopissis (see Clausen et al. col 1 lines 43-47), Clausen et al. teach not only that the diaminopyrazoles are used for the same purpose, but also, they are an improvement over two of the three conventional developers used by Kalopissis. It is *prima facie* obvious to combine two compositions each taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. See *In re Kerkhoven*, 205 USPQ 1069, 1072. For this reason it would also have been obvious to use the diaminopyrazole couplers in combination with the developers taught by Kalopissis. In response to the argument that the combination is contrary to the express teachings of Clausen et al, applicant refers to the preferred couplers of Clausen et al. All disclosures of the prior art, including non-preferred embodiment, must be considered. See *In re Lamberti and Konort*, 192 USPQ 278 (CCPA 1967); *In re Snow* 176 USPQ 328(CCPA 9173) All of the disclosures in a reference must be evaluated for what they fairly teach to one or ordinary skill in the art. *In re Smith*, 32 CCPA 959, 148 F.2d 351, 65 USPQ 167; *In re Nehrenberg*, CCPA 1159, 280 F. 2d 161, 126 USPQ 383. Note M.P.E P. 2123,"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain. *In re Heck*, 699 E.2d 1331, 1332-1333, 216 USPQ 1038, 1039 (Fed Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968). A reference

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may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843(Fed. Cir.) *cert. denied*, 493 U. S. 975 (1989). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). In this case, Clausen fairly teaches that all known couplers that are used in hair dyeing compositions may be used with the developers of the invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,090,162. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent recite hair dyeing compositions which contain a diaminopyrazole oxidation

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base and halogenated m-aminophenol coupler, both of which overlap in scope with those as currently claimed, as well as the corresponding hair dyeing methods and kits.

Response to Amendment

Applicant's amendment did not address the above rejection and thus it is maintained.

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is (703) 308-3826. The examiner can normally be reached on Monday to Thursday and alternate Fridays from 7:00 A.M. to 4:30 P.M. The fax phone number for this Technology Center is (703) 305-3599

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



MARGARET EINSMANN

PRIMARY EXAMINER 1751

June 12, 2001